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**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Joseph C. Kawan  
Serial No.: 09/238,995  
Filing Date: January 28, 1999  
For: **METHOD AND SYSTEM OF CONTACTLESS  
INTERFACING FOR SMART CARD BANKING**  
Examiner: Akers, G.  
Art Unit: 2164

**AMENDMENT AND RESPONSE TO OFFICE ACTION**

Assistant Commissioner of Patents  
Washington, DC 20231

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**DEC 16 2004**

**GROUP 3600**

Sir:

The following amendment and remarks are submitted in response to the Office Action mailed March 13, 2001 in the above-identified application. Please amend the above-referenced application as follows:

*In the Claims:*

Please rewrite claim 1 as follows:

1. (Amended) A method of contactless interfacing for a smart card, comprising:  
establishing a physical contact communication for accessing a smart card  
application;  
initiating a contactless communication for a user between the smart card  
application and an on-line system;  
verifying authorization for the communication for the user; and  
communicating information for the user to the on-line system.

Please cancel claim 32 and claims 34-38.

Please rewrite claims 63 and 67 as follows:

63. (Amended) A contactless interface system for a smart card, comprising:  
means for establishing a physical contact communication for accessing a smart card application;  
means for initiating a contactless communication between the smart card application and an on-line system;  
means associated with the initiating means for verifying authorization for the communication; and  
means associated with the verifying means for communicating information to the on-line system.

67. (Amended) The system of claim 63, wherein the smart card application comprises the smart card application on a smart card microprocessor.

Please add new claims 79-81:

79. (New) The method of claim 1, wherein the accessing of the smart card application comprises executing the smart card application.

80. (New) The method of claim 1, wherein the accessing of the smart card application comprises loading the smart card application.

81. (New) The method of claim 80, further comprising iteratively performing:  
the initiating of a contactless communication;  
the verifying authorization; and  
the communicating information.

### **REMARKS**

The foregoing amendment clarifies the expression of the invention. For example, claims 1 and 65 now include the physical contact communication to access the smart card application prior to initiating the contactless communication (Spec. page 2, line 6). Claim 32 has been canceled because the limitations contained therein are encompassed in Claim 1 as amended. The applicant has cancelled Claims 34-38 but may include the subject matter in continuing applications.

Claims 79 – 81 have been added to focus on the alternative methods an embodiment of the present invention may utilize to perform the accessing of the smart card application. In one embodiment of the present invention, accessing the smart card application comprises executing a smart card application (Spec. p. 9, line 12). In another embodiment, accessing the smart card application comprises loading a smart card application in order that contactless communications may be performed iteratively without a need to establish a subsequent physical contact communication (Spec. p. 10, lines 20-24).

Also, upon review of the application, applicant noted that in claim 67, the term “remote” lacked antecedent basis. Applicant has therefore deleted the word, “remote,” and added the words, “smart card,” to correct the error.

The draftsman’s objections to the drawings are noted. Applicant will submit formal drawings upon receipt of the notice of allowance.

Claims 1-31, 33 and 39-81 are pending in this application. Claims 1-31, 33 and 39-78 stand rejected under 35 U.S.C. 103(a). Reconsideration of the claims is respectfully requested.

#### **A. Rejection of Claims 1, 6-10, 15-18, 20-23, 25-28, 20-31, 33, 39-51, 53, 55-59, 61-63, 67-69, 71, 73-76 and 78 under 35 U.S.C. 103(a)**

The rejection of claim 1 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,943,624 issued to Fox, et al. (hereinafter “Fox”) in view of U.S. Patent No. 5,461,217 issued to Claus (hereinafter “Claus”) is respectfully traversed. The asserted references teach away and do not suggest the present invention.

In the process of claim 1, the holder of a smart card establishes a physical communication between a device and the smart card to access a smart card application. The holder then utilizes

the device to initiate a contactless communication between the smart card application and a terminal. The smart card comprises a standard credit card-type smart card. For example, in an embodiment of the present invention, a smart card is inserted into a personal digital assistant (PDA) or other device (Spec. p. 7, line 23) and the PDA initiates the contactless communication with an on-line system. Advantages of embodiments of the present invention include not only increasing the durability of the smart card, but also improving the ease-of-use of the smart card.

Fox describes an invention to improve the durability of a smart card (Spec. Col 5, line 51), but Fox teaches away and does not suggest the present invention. Fox describes a cellphone that "includes cellular telephone circuitry and smart card circuitry...for performing both a cellular telephone function and a smart card function." (Col. 2, lines 13-16). Fox teaches away and does not suggest a physical contact communication between a smart card and another device, and in fact, teaches away from retaining a smart card, discussing the various problems associated with the credit card-type smart card. Fox states:

Accordingly, it would be desirable to incorporate the electronics associated with a smart card into an alternate housing arrangement so as to overcome problems and disadvantages associated with flexible plastic smart cards. Additionally, it would be desirable to provide a smart card that does not require contact with an external reader in order to perform a transaction. (Col. 1, lines 31-52)

Maintaining a physical, distinct smart card as in the present invention provides numerous advantages over Fox. For example, numerous devices may be utilized to provide contactless communication for a single smart card. Also, numerous smart cards may utilize a single device to perform contactless communication. Fox teaches away such flexibility. Additionally, the smart card may be used independently of the device, either via a physical contact with a terminal or via an alternate device.

Fox not only teaches away from the present invention, but as the examiner states, Fox also fails to disclose on-line communication. Office Action, mailed March 13, 2001, p.2. The examiner states that Claus teaches on-line communication between smart cards. *Id.* While Claus

teaches on-line communication between smart cards, Claus teaches away and does not suggest contactless communication for a user between the smart card application and an on-line system..

Claus teaches communication between smart cards. (Spec. col.2, line 34) In order to accomplish the communication, Claus requires at least two smart card readers be linked in a smart card reader network. (Spec. col. 4, line 24) Claus does not suggest alternative methods for communication between a smart card and an on-line system, but rather teaches a method of enhancing the administration of smart cards through intercard communication.

In contract, the present invention is directed to establishing a physical contact communication between a smart card and a device to access a smart card application and initiating a contactless communication between the smart card application and an on-line system.

Since Fox and Claus teach away and do not suggest the present invention, the applicant respectfully requests that the examiner withdraw the rejection of claim 1. Claims 6-10, 16-18, 20-23, 25-28, 20-31, 33, 39-51, 53, 55-59 and 61-62 depend from claim 1. For the reasons stated herein and because applicant believes claim 1 to be patentable, applicant respectfully requests that the examiner withdraw the rejection of claims 6-10, 16-18, 20-23, 25-28, 20-31, 33, 39-51, 53, 55-59 and 61-62.

Further, Claim 63 describes a system, including a means for establishing a physical contact communication. Because Fox teaches away and does not suggest a means for establishing a physical contact communication applicant believes claim 63 to be patentable as well and respectfully requests that the examiner withdraw the rejection of claim 63. Furthermore, claims 67-69, 71, 73-76 and 78 depend from claim 63. For the reasons stated herein and because applicant believes claim 63 to be patentable, applicant respectfully requests that the examiner withdraw the rejection of claims 67-69, 71, 73-76 and 78.

The rejection of claim 15 under 35 U.S.C. 103 (a) as being unpatentable over Fox in view of Claus and further in view of U.S. Patent No. 5,789,733 issued to Jachimowicz (hereinafter "Jachimowicz") is respectfully traversed. Claim 15 depends from claim 1. For the reasons stated herein, applicant believes claim 1 is patentable, and therefore, claim 15 is patentable as well. Applicant respectfully requests that the examiner withdraw the rejection of claim 15.

**B. Rejection of Claim 5 under 35 U.S.C. 103(a)**

The rejection of claim 5 under 35 U.S.C. 103 (a) as being unpatentable over Fox in view of Claus in view of U.S. Patent No. 5,929,414 issued to Saitoh (hereinafter "Saitoh") and further in view of U.S. Patent No. 5,789,733 issued to Jachimowicz (hereinafter "Jachimowicz") is respectfully traversed.

Claim 5 depends from claim 1. For the reasons stated in section A. above, applicant believes claim 1 is patentable, and therefore, claim 5 is patentable as well. Applicant respectfully requests that the examiner withdraw the rejection of claim 5.

**C. Rejection of Claim 13 under 35 U.S.C. 103(a)**

The rejection of claim 13 under 35 U.S.C. 103 (a) as being unpatentable over Fox in view of Claus in view of Jachimowicz further in view of U.S. Patent No. 5,590,038 issued to Pitroda (hereinafter "Pitroda") is respectfully traversed.

Claim 13 depends from claim 1. For the reasons stated in section A. above, applicant believes claim 1 is patentable, and therefore, claim 13 is patentable as well. Applicant respectfully requests that the examiner withdraw the rejection of claim 13.

**D. Rejection of Claim 66 under 35 U.S.C. 103(a)**

The rejection of claim 66 under 35 U.S.C. 103 (a) as being unpatentable over Fox in view of Claus further in view of Saitoh is respectfully traversed.

Claim 66 depends from claim 63. For the reasons stated in section A. above, applicant believes claim 63 is patentable, and therefore, claim 66 is patentable as well. Applicant respectfully requests that the examiner withdraw the rejection of claim 66.

**E. Rejection of Claim 2-4, 11-12, 14 and 65-66 under 35 U.S.C. 103(a)**

The rejection of claims 2-4, 11-12 and 65 - 66 under 35 U.S.C. 103 (a) as being unpatentable over Fox in view of Claus further in view of Jachimowicz is respectfully traversed.

Claims 2-4, 11-12 and 14 depend from claim 1. For the reasons stated in section A. above, applicant believes claim 1 is patentable, and therefore, claims 2-4, 11-12 and 14 are patentable as well. Claims 65-66 depend from claim 63. For the reasons stated in section A.

above, applicant believes claim 63 is patentable, and therefore, claims 65-66 are patentable as well. Applicant respectfully requests that the examiner withdraw the rejection of claims 2-4, 11-12 and 65 - 66.

**F. Rejection of Claim 19, 24, 29, 36, 52, 54, 60, 70, 72 and 77 under 35 U.S.C. 103(a)**

The rejection of claims 19, 24, 29, 36, 52, 54, 60, 70, 72 and 77 under 35 U.S.C. 103 (a) as being unpatentable over Fox in view of Claus further in view of Pitroda is respectfully traversed.

Claims 19, 24, 29, 36, 52, 54 and 60 depend from claim 1. For the reasons stated in section A. above, applicant believes claim 1 is patentable, and therefore, claims 19, 24, 29, 36, 52, 54 and 60 are patentable as well. Claims 70, 72 and 77 depend from claim 63. For the reasons stated in section A. above, applicant believes claim 63 is patentable, and therefore, claims 70, 72 and 77 are patentable as well. Applicant respectfully requests that the examiner withdraw the rejection of claims 19, 24, 29, 36, 52, 54, 60, 70, 72 and 77.

**Version With Marking To Show Changes Made**

**Amendments in the Claims:**

In accordance with 37 CFR 1.121(c), the following versions of the claims as rewritten by the foregoing amendment show all the changes made relative to the previous versions of the claims.

1. (Amended) A method of contactless interfacing for a smart card, comprising:  
establishing a physical contact communication for accessing a smart card application;  
initiating a contactless communication for a user between [a] the smart card application and an on-line system;  
verifying authorization for the communication for the user; and  
communicating information for the user to the on-line system.
63. (Amended) A contactless interface system for a smart card, comprising:  
means for establishing a physical contact communication for accessing a smart card application;  
means for initiating a contactless communication between [a] the smart card application and an on-line system;  
means associated with the initiating means for verifying authorization for the communication; and  
means associated with the verifying means for communicating information to the on-line system.
67. (Amended) The system of claim 63, wherein the [remote] smart card application comprises the smart card application on a smart card microprocessor.

Claims 32 and 34-38 have been cancelled.



79. (New) The method of claim 1, wherein the accessing of the smart card application comprises executing the smart card application.

80. (New) The method of claim 1, wherein the accessing of the smart card application comprises loading the smart card application.

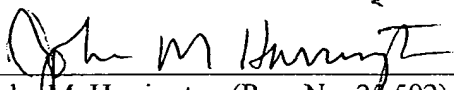
81. (New) The method of claim 80, further comprising iteratively performing:  
the initiating of a contactless communication;  
the verifying authorization; and  
the communicating information.

### CONCLUSION

In view of the foregoing amendments and these remarks, each of the claims remaining in the application is in condition for immediate allowance. Accordingly, applicant respectfully requests the Examiner to reconsider and withdraw the rejection and to pass the application to issue.

Respectfully submitted,

Date: 9/13/01

  
John M. Harrington (Reg. No. 23,592)  
for George T. Marcou (Reg. No. 33,014)

Kilpatrick Stockton LLP  
607 14<sup>th</sup> Street, NW, Suite 900  
Washington, DC 20005  
(202) 508-5800

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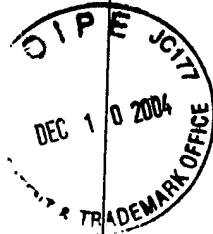
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**POSTCARD ACKNOWLEDGEMENT OF RECEIPT OF  
PAPERS BY PATENT AND TRADEMARK OFFICE**

The following papers were received in the U.S. Patent and Trade Office:

Applicant: Joseph C. KAWAN

Title of Invention: METHOD AND SYSTEM OF CONTACTLESS INTERFACING FOR  
SMART CARD BANKING

C/M# T0091/171028. Serial No .09/238,995... Filed .January .28, .1999

☐ Specification-No. of Pages

☒ Amendment

☐ Claims-No. of Claims

☒ Request for Extension of Time  
(duplicate)

☐ Drawings-No. of Sheets

☒ Fee: Enclosed \$ 890.00

☐ Declaration and Power of Attorney

☒ Certificate of Express Mail

☐ Assignment

No.: EL 894963387 US

☐ Issue Fee \$ \_\_\_\_\_

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